

REMARKS/ARGUMENTS

Preliminarily, Applicants note that the Examiner has cited claim 7, in the present Official Action, paragraph 5, asserting that "the diol" lacks antecedent basis in claim 1. However, claim 7 was not in the listing of claims rejected under 35 U.S.C. §112, second paragraph (see paragraph 2 of the present Official Action). Therefore, the Applicants have addressed the present Official Action under the assumption that the Examiner has also rejected claim 7 under 35 U.S.C. §112, second paragraph.

Reconsideration and allowance of the present application based on the following remarks are respectfully requested. Claims 1, 7, 13, 20-22, 24, and 29 have been amended. New claims 33-34 have been added. Support for the amendments may be found throughout the specification. No new matter has been added as a consequence of these amendments.

Claims 1-4, 9-26 (and 7) are rejected under 35 U.S.C. §112, second paragraph, for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. The Applicants do not agree with the Examiner's assertion that component (a) is indefinite. Specifically, one of skill in the art would understand what "a polyester formed from" requires. However, the pending claims, as amended, are believed to render these rejections as moot. Accordingly, it is submitted that the claims, as amended, are in full compliance with 35 U.S.C. §112, first and second paragraphs, and a withdrawal of these rejections is requested.

Claims 1-3, 7, 12, and 23-26 stand rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Patent 6,610,811 ("Westfechtel"). Claims 10, 14-19, and 29-32 stand rejected under 35 U.S.C. §102(e) as being anticipated by or, in the alternative, under 35 U.S.C. §103(a) as being obvious over Westfechtel.

Claims 1, 3-4, 7, and 20 stand rejected under 35 U.S.C. §102(e) as being anticipated by JP 2003-013032 ("Tetsuo"). Claims 10, 14-19, 24, 26, 29, and 31 stand rejected under 35 U.S.C. §102(e) as being anticipated by or, in the alternative, under 35 U.S.C. §103(a) as being obvious over Tetsuo.

Claims 1, 3-4, and 9 stand rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent 3,264,236 ("Santaniello"). Claims 10, 14-19, 24, and 26 stand rejected under 35 U.S.C. §102(b) as being anticipated by or, in the alternative, under 35 U.S.C. §103(a) as being obvious over Santaniello.

Claims 9, 11, and 20 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Westfechtel. Claims 1-4, 7, 9-20, 23-26, and 29-32 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Westfechtel in view of Tetsuo. Claims 21-22 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Westfechtel in view of U.S. Patent 5,994,493 ("Krebs"). Claims 21-22 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Tetsuo in view of Krebs. Claims 21-22 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Westfechtel in view of Tetsuo and Krebs.

For at least the following reasons, the claims are believed to be patentable over the cited references.

Applicants note that the moisture-curable adhesives of the pending claims, as amended, comprise the reaction product of at least one polyisocyanate and at least one polyol, comprising a polyester, wherein the NCO:OH molar ratio of the polyisocyanate and the polyester is 2:1 to 16:1. In contrast, the NCO:OH ratio of the polyurethanes in Westfechtel's is between 1.2:1 to 0.8:1 (see Westfechtel at col. 5, lines 21-24). Accordingly, Applicants submit that not only does Westfechtel not anticipate, but teaches away from the adhesives of the pending claims. Moreover, it is noted that none of the other cited references cure this deficiency.

Turning to the adhesive compositions of Tetsuo, it is noted that these compositions comprise aromatic acids (see Tetsuo at paragraphs 26-28). In contrast, Applicants direct the Examiner's attention to the non-dimer fatty acids of the pending claims, as amended, which are linear dicarboxylic acids, *i.e.* not aromatic acids.

In regards to Santaniello, Applicants submit that Santaniello's fuel-binders cure at temperatures of 100 °F (see Santaniello at col. 2, lines 23-24) over a 48 hour period (see Santaniello at col. 3, lines 38-40). However, the adhesives of the pending claims are "moisture-curable". In addition, it is also noted that while the isocyanate content of Santaniello's composition is approximately 6% (see Santaniello at col. 3, line 20), the isocyanate content of the pending claims, for example claim 12, is in the range from 12 to 30% by weight NCO, relative to the weight of the adhesive.

Finally, Krebs fails to cure the noted deficiencies of the cited primary references. Accordingly, as all objections and rejections having been addressed, it

is respectfully submitted that the present application is in a condition for allowance and a Notice to that effect is earnestly solicited.

Should any issues remain unresolved, the Examiner is encouraged to contact the undersigned attorney for Applicants at the telephone number indicated below in order to expeditiously resolve any remaining issues.

Respectfully submitted,

JONES DAY

By: 

Paul L. Sharer
Registration No. 36,004
Direct No. (202) 879-5481

Intellectual Property Group
51 Louisiana Avenue, N.W.
Washington, D.C. 20001-2113
(202) 879-3939 Telephone
(202) 626-1700 Facsimile

Date: September 9, 2009